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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Old Ironsides Foundation, Inc.

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Serial No 74/540,679

Wayne M. Kennard of Hale and Dorr, LLP. For Old Ironsides
Foundation, Inc.

Conrad Wal-pac Wong, Trademark Examining Attorney, Law
Office 104 (Sidney I. Moskowitz, Managing Attorney).

Before Cissel, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge

On June 21, 1994, applicant filed the above-referenced
application to register the mark shown below



on the Principal Register for what were subsequently identified by amendment as "headwear, namely, hats, clothing caps, visors, and headbands; t-shirts; sweatshirts; sweaters; jackets; neckties; scarves," in Class 25. The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce

The Examining Attorney made of record information establishing that "OLD IRONSIDES" is the name used synonymously with "the U.S.S. Constitution" in reference to the famous warship of the United States Navy. Applicant is a foundation directly associated with the ship, and is the entity which has the authority to conduct the bicentennial celebration commemorating the launching of it. "Old Ironsides" saw duty in the War of 1812, and is now the oldest commissioned ship in the U.S. Navy.

For reasons not entirely clear to us, the Examining Attorney required applicant to disclaim the words "OLD IRONSIDES 200 YEARS" apart from the mark as shown. Even more surprising, applicant complied with the requirement without comment. Whether the requirement was proper is therefore not an issue on appeal.

This application is now before the Board on appeal from the final refusal to register under Section 2(d) of the Act. The Examining Attorney has determined that applicant's mark,

if used in connection with the apparel specified in the application, so resembles the mark shown below,



which is registered¹ on the Principal Register for "hosiery," that confusion would be likely.

After carefully considering the record before us and the relevant legal authorities, we agree. Confusion is likely because the marks create similar commercial impressions and the goods set forth in the application are related to the goods specified in the registration.

It is well settled that in resolving the issue of whether confusion is likely, we must consider the marks in their entireties. There is nothing improper, however, in recognizing that more weight may be given to one part of the respective marks, provided that the ultimate conclusion

¹ Reg. No. 659,388, issued to Feldan Brothers, Inc. on March 11, 1958, and subsequently renewed

regarding the likelihood of confusion results from consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this regard, in the case at hand, as in many other situations where words are combined with design elements, it is the word portions of the marks which are dominant. See. See: Ceccato v. Manifattura Land Gaetano Marzotto Figli S.p.a., 32 USPQ2d 1192 (TTAB 1994). Especially in view of the historical significance and notoriety of "Old Ironsides," that term dominates each of these two marks. We note further that "OLD IRONSIDES" is the only part of the marks which can be articulated. Thus, the words must be accorded greater weight in our analysis because they will be used by consumers in calling for both parties' goods. It is "OLD IRONSIDES," the nickname of the Navy warship, which is primarily responsible for the commercial impression each mark creates.

The registered mark shows a ship design in an oval in addition to the words, "OLD IRONSIDES." If anything, the illustration of the ship simply reinforces the commercial impression of the famous sailing vessel. The mark applicant intends to use combines the same words with a stylized depiction of the flag of the United States and the designation "200 YEARS." While the numerals "200" and the

flag design are larger than the words "OLD IRONSIDES," the historic significance of the nickname for the ship has the effect of making that name the dominant part of that mark as well. Consumers would naturally assume that the designation "200 YEARS" and the flag design indicate the age and national significance of the historic ship. In summary on this point, because each mark is dominated by the same term, "OLD IRONSIDES," the marks in their entireties create quite similar commercial impressions.

The use of these similar marks in connection with related goods would be likely to cause confusion within the meaning of Section 2(d) of the Act. The Examining Attorney made of record copies of several third-party registrations wherein the list of goods includes both hosiery and at least one of the other items of clothing set forth in the application here at issue. These third-party registrations help establish what common experience may suggest anyway, that consumers have reason to expect that the use of similar marks in connection with both hosiery and the clothing items set forth in the application indicates that the goods all emanate from the same source. See: Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993)

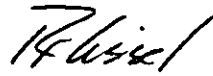
Applicant's argument that the channels of trade through which its products will move in commerce will be different from those for the goods of the owner of the cited

registration is not persuasive. The question of whether confusion is likely is determined on the basis of the ways the goods are identified in the application and the registration, respectively, and unless the limitations or restrictions argued by an applicant in the trade channels, purchasers, or uses of the products are reflected therein, we will not consider them. *Toys "R" Us, Inc. v. Lamps R Us*, 219 USPQ 340 (TTAB 1983). For our purposes, then, we must consider registrant's hosiery to move in all the usual channels of trade to all the normal purchasers of such goods, and these are the very same trade channels and purchasers for the clothing products listed in the application.

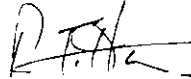
We have no doubt that if applicant were to use its mark on the products listed in the application, confusion would be likely in view of the cited registration of a similar mark for related clothing items. Even if we did have doubts, however, such doubts would necessarily be resolved in favor of the registrant and prior user. In *re Apparel, Inc* , 578 F.2d 308, 151 USPQ 353 (CCPA 1966).

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Accordingly, the refusal to register is affirmed.



R. F. Cissel



P. T. Hairston



C. E. Walters

Administrative Trademark Judges
Trademark Trial & Appeal Board

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